

REMARKS

Claims 1-12 were pending in the current application. Applicant has added claims 13-19. Reexamination and reconsideration of all claims, as amended, are respectfully requested.

§ 103

The Office Action rejected claims 1-12 under 35 U.S.C. § 103(a) based on de la Huerga, U.S. Patent 5,960,085 (“de la Huerga ‘085”) in view of de la Huerga, U.S. Patent 6,346,886 (“de la Huerga ‘886”). Applicant respectfully traverses these rejections.

de la Huerga ‘085 is directed to a system utilizing a personal identification badge to collect data and provide access to a computer terminal. (de la Huerga ‘085, Abstract.). In the de la Huerga ‘085 design, each computer terminal having access to a database on the hospital computer network is equipped with a device for wireless information exchange with the security badge, using infrared transmitters and detectors. (Col. 4, ll. 40-44) To access a computer terminal, a system user positions himself in front of the computer terminal so that a generally unobstructed signal path exists between the security badge and the computer terminal. (Col. 4, ll. 44-49). The computer terminal intermittently transmits “interrogation” signals to detect, authenticate, and establish communications with nearby security badges. (Col. 4, ll. 49-53) If a system user is properly positioned, the security badge may capture and process these interrogation signals, returning a signal by which the security verification system of the hospital computer network can authenticate (i.e., identify and verify) the access privileges of the system user, using public key cryptography in this identification process. (Col. 4, ll. 53-58). If the security badge is authenticated through this cryptographic exchange, the system user is automatically logged onto the hospital computer network. (Col. 4, ll. 59-61) The computer terminal displays the system user's own customized startup page through an interactive, hypertext-capable browser interface, and the system user may do anything consistent with the access privileges associated with the security badge. (Col. 4, ll. 61-65).

As recited in the claims of the present application, particularly claim 1, Applicants' invention requires, *inter alia*:

providing a badge secured to one of said authorized individuals, said badge having nonvolatile and volatile memory and an attachment sensor, the attachment sensor causing information stored in volatile memory to be rendered unreadable when the attachment sensor detects removal of the badge, **(the “badge providing limitation”)**; and

causing an administrative computer to load information in volatile memory of the badge in response to an identity verification system authenticating that individual, the information specifying the level of access to the computer system to which that authorized individual is entitled **(the “causing limitation”)**.

The Office Action contends that the causing limitation of claim 1 is shown by de la Huerga '085 purportedly teaching:

that if the security badge is authenticated through a cryptographic exchange, the system user is automatically logged onto the network and that the computer terminal displays the system user's own customized startup page through an interactive, hypertext-capable browser interface where the system user may do anything consistent with the access privileges associated with the security badge.

Office Action, p. 3, citing de la Huerga '085, col. 4, ll. 59-65 and col. 11, ll. 30-45.

While de la Huerga '085 discloses such an interaction, Applicants do not agree that this security badge authentication aspect of de la Huerga '085 meets the causing limitation of claim 1. The causing limitation of claim 1 requires (1) causing the administrative computer to load information in volatile memory of the badge; (2) the loading of information caused in response to the identity verification system authenticating that individual, the information specifying the level of access to the

computer system to which the individual is entitled. The de la Huerga '085 design, in contrast, specifies a badge including the "base contents" of FIG. 8 of de la Huerga '085 (e.g., password or private/public security keys, user name, used ID number, access privileges) and the badge provided to the authorized individual. No transmission of information from the administrative computer to the badge is disclosed in the cited passage of de la Huerga '085, nor is information loaded into memory in response to the system authenticating the individual as required by the express claim language of Claim 1. de la Huerga '085 simply provides a design that receives information from the badge and authenticates the individual as appropriate. In short, the requirements of the causing limitation of Claim 1 are not shown by de la Huerga '085.

The Office Action further cites de la Huerga '866 in rejecting the claim. While not specifically discussed in the Office Action, the causing limitation is also not shown in the de la Huerga '866 reference. Applicants respectfully submit that the absence of the claim 1 causing limitation from both of the cited references constitutes a specific element not shown by the references of record, rendering claim 1 and all claims dependent therefrom allowable over the references.

Further, as recognized in the Office Action, missing from de la Huerga '085 is the concept of "an attachment sensor for detecting the removal of said badge from that individual, said attachment sensor causing information stored in said volatile memory to be rendered unreadable when said attachment sensor detects said removal," required by the badge providing limitation of claim 1. The Office Action relies on de la Huerga '866 for this feature, stating:

[de la Huerga ('866)] discloses an electronic identification apparatus (i.e., a badge) having data storage memory on board a removable transceiver device....

Office Action, pp. 3-4.

Applicants disagree that the '886 apparatus can be termed a "badge," as that term is commonly used and discussed in the present application as well as the de la

Huerga '085 and de la Huerga '866 patents. In particular, FIG. 1 of de la Huerga '085 illustrates a "security *badge*," while FIG. 2 of de la Huerga '085 shows a "wrist bracelet," similar to the wrist bracelet of de la Huerga '866, indicating a badge and a bracelet, or wrist bracelet, are two different devices.

While the de la Huerga '866 device may include an integrated wrist bracelet and transceiver, such as in FIGs. 26-28, such a wrist bracelet device requires the use of a specialized contact design to determine when the bracelet has been removed from the individual. The FIGs. 26-28 design uses a set of contacts, where snaps 2160 are pressed into holes 2164 placing the snaps in electrical contact with contacts 2166. Such a design could not be used with the currently claimed badge to produce the design claimed in Claim 1. Placement of contacts and other devices to secure the badge to the person would not operate either as claimed or in a generally desirable manner. Snaps and contacts affixing the device to an individual would generally be undesirable.

The de la Huerga '866 device materially differs from the present claims, including claim 1, which requires an attachment sensor detect the removal of *a badge* from the individual, not removal of a wrist bracelet, and particularly not removal using the snaps and contact arrangement as shown in de la Huerga '866. Put simply, one could not use the de la Huerga '866 wrist bracelet contacts and snaps mechanism with the de la Huerga '085 badge.

The interesting aspect of the present rejection in the Office Action is that both references cited in rejecting, *inter alia*, claim 1 are patents granted to the same individual. Mr. de la Huerga, in the references presented, did not disclose the combination now being asserted in the Office Action in either reference. Further, neither reference discloses a badge removal security aspect as presently claimed by Applicants. In short, the claimed design appears to have been "un-obvious" to Mr. de la Huerga.

Applicants thus further dispute the combination of the two de la Huerga references in the manner suggested in the Office Action. Applicants respectfully submit that no motivation to combine the references in the manner suggested is

presented within the de la Huerga references themselves. With respect to the motivation to combine de la Huerga '085 with de la Huerga '866, the Office Action merely states that it would have allegedly been obvious to modify the security badge disclosed in '085 with that of '866 "to make it more difficult to remove the badge from the bracelet so it can not inadvertently be removed, dislodged, or [replaced] while secured to the patient.", citing the description at col. 4, l. 62 – col. 5, l. 11 of de la Huerga '085. First, it is not understood what is meant by "more difficult to remove the badge from the bracelet." As noted, a badge differs from a bracelet or wrist bracelet as shown, for example, in FIGs. 1 and 2 of de la Huerga '085. Second, if it was indeed obvious, which it is not, Applicants submit that inventor de la Huerga would have included the concept somewhere in the cited references, which he did not. de la Huerga '085 teaches a badge and a wrist bracelet used in a particular security system that differs from that presently claimed, while de la Huerga '866 discloses a wrist bracelet arrangement that can operate to erase information when the wrist bracelet is removed from the individual.

As previously noted, these elements function completely differently from the limitations included in claim 1 in that the both the de la Huerga '085 system and the '866 system do not include the "causing" limitation of claim 1, i.e. do not cause an administrative computer to load information in volatile memory of the badge in response to an identity verification system authenticating that individual, the information specifying the level of access to the computer system to which that authorized individual is entitled. The de la Huerga '866 wrist bracelet does not include the "badge providing" limitation of claim 1, and does not include an attachment sensor for detecting the removal of a badge from an individual as required by the express language of the claim. The statement in the Office Action does not demonstrate any motivation to combine the references explicit or implied within the two de la Huerga references themselves, but instead recites a desired result, namely making the device more difficult to remove. Applicants contend that no motivation to employ the de la Huerga '085 design is included in de la Huerga '866, and certainly no motivation to employ the design of de la Huerga '866 is included in de la Huerga '085.

The Federal Circuit has held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital System, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Without some showing in the prior art that suggests in some way a combination in order to arrive at the claimed invention, it is impermissible to use the Applicant's teaching to search references for the claimed elements and combine them as claimed. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also, Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947) ("It seems to us that the Examiner is using appellant's disclosure for the suggestion of the combination since there is no suggestion in any of the patents for their combination in the manner claimed by Applicant."); *In re Leonor*, 158 U.S.P.Q. 20, 21 (C.C.P.A. 1968) (the issue is "whether teachings of prior art would, of themselves, and without benefit of applicant's disclosure, suggest [a process] which would make claimed invention obvious..." (emphasis in original)). As noted, the de la Huerga '085 reference does not suggest combining the badge design disclosed with the removable wrist bracelet security aspect of de la Huerga '866 to produce the unique system claimed in Applicants' independent claim 1.

Applicants respectfully submit that the Office Action uses hindsight in rejecting the claims herein. It is only through hindsight, after seeing Applicants' disclosure, that it would be considered possible to create the access control method as claimed by the Applicants.

With regard to the use of hindsight, or the use of an Applicant's teaching to combine references, the courts have overwhelmingly condemned such combinations and have upheld the validity of patents or claims of patents in which such hindsight was employed to combine the references. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), (condemning the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher"); *In re Fine*, 837 F.2d 1044, 1051 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.") Applicants respectfully submit that combination of aspects of the de la Huerga '085 reference with the de la Huerga '866 design is merely a hindsight

reconstruction of the invention using Applicants' disclosure and claims as a guide. Such hindsight reconstruction of the claimed system is inappropriate and thus rejection of the independent claim 1 for this reason is improper.

Based upon the totality of the foregoing, Applicants respectfully submits that claim 1 is allowable over the references of record, and that all claims dependent from claim 1 are allowable as they depend from an allowable base claim. Further, the newly added independent claims contain similar limitations to those of claim 1 and the newly added independent claims and claims dependent therefrom are allowable over the cited references for the reasons presented.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

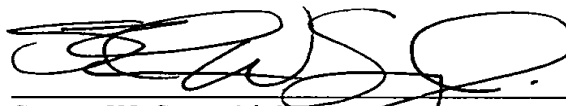
CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims are respectfully requested, and allowance of all the claims at an early date is solicited.

Should it be determined for any reason an insufficient fee has been paid, please charge any insufficiency to ensure consideration and allowance of this application to Deposit Account 08-2025.

Respectfully submitted,

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